

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 28, 2008. At the time of the Final Office Action, Claims 1-8 were pending in this Application. Claims 1-8 were rejected. Claims 1 and 8 have been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,317,418 issued to Mika Raitola et al. (“*Raitola*”) in view of U.S. Patent 6,388,999 issued to Thomas E. Gorsuch et al. (“*Gorsuch*”). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicant amended independent claims 1 and 8 to include that a common channel description is transferred by the base station to the subscriber station which includes information not only about which channels are used in a predefined direction but also in which order these channels have to be used.

The Examiner stated that *Raitola* allegedly discloses such a transmission scheme. Applicant respectfully disagrees. The Examiner stated in particular, that *Raitola* allegedly discloses to identify a plurality of channels usable for transmission in one direction in col. 5, lines 20-23 and col. 11, lines 1-3. Applicant respectfully disagrees. Col. 5, lines 20-23 of *Raitola* merely discloses the use of a base station and a mobile subscriber terminal. Col. 11, lines 1-3 merely states that the network part (base station) announces on which particular channel a subscriber terminal should transmit a certain transmission unit. The subscriber terminal is identified by a certain RID and has to monitor the occurrence of the RID on the control channel CCH and when it finds its own RID on this channel it transmits the data on this channel. *Raitola*, col. 11, lines 4-10. However, no common channel description is transmitted that identifies a plurality of channels that are assigned for a specific transmission.

The Examiner further concluded that *Raitola* discloses in col. 10, lines 65-67 that a common channel description also specifies in which order data is to be transmitted over the identified channels. Applicant respectfully disagrees. No common channel description is transmitted that identifies a plurality of channels because *Raitola* merely announces which channel has to be used. Thus, a subscriber terminal must constantly listen to the control channel until his RID is identified. Only then the subscriber terminal will know that he can use this channel. *Raitola*, col. 11, lines 4-10. Thus, the concept of *Raitola* is to indicate in real time which channel can be used for transmission by a subscriber terminal. This concept requires a permanent transmission of data on the control channel to control the actual data transmission.

Contrary to this concept, the method and apparatus as defined in the independent claims transmit a common channel description to the subscriber terminal that includes information about which channels are used and in which order they have to be used. *Gorsuch* does not fill the gap between the subject matter as claimed and *Raitola*.

Hence, Applicant believes that the independent claims are patentable in view of the cited prior art. Applicant respectfully submits that the dependent Claims 2-7 are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of all pending Claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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